

REMARKS

In a Final Office Action dated September 22, 2005, claims 28-30 were withdrawn from consideration as allegedly being directed to a non-elected invention; objections were made to claims 12-14 and 18; claims 1, 2, 6, 10-12, 18 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Martin; claims 1, 2, 9, 18 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Collins; claims 1, 6 and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fritsch; claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fritsche; claims 14-17, 22 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fritsche in view of Stepp; claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins; claims 25-27 were allowed; and claim 23 was objected to as being dependent upon a rejected base claim but was indicated as being allowable if rewritten in independent form. For purposes of expediting prosecution, claims 14-17, 22-24 and 28-30 have been cancelled. Dependent claim 23 has been rewritten in independent form as newly-added independent claim 31. Because the Examiner indicated that claim 23 was allowable if rewritten in independent form, allowance of newly-added independent claim 31 is requested for at least this reason. Claims 12, 14 and 18 have been amended to overcome the § 112 rejections. The §§ 102 and 103 rejections are addressed below.

§§ Rejections of Claims 1-3, 6 and 9-13:

The seal element of independent claim 1 includes an energizing element that is adapted to store potential energy prior to a packer being run to a predetermined position in a well and is adapted to release at least some of the potential energy at a predetermined position to radially expand the energizing element.

Contrary to the limitations of independent claim 1, Martin discloses a packer that includes leaves B that bulge outwardly toward the sides of the well in response to a weight of a tube. *See, for example*, lines 11-28 in column 3 of Martin. However, Martin fails to teach or even suggest an energizing element that stores potential energy prior to a packer being run into a well so that at least some of the potential energy is released to radially expand the energizing element. Instead of storing the potential energy, Martin merely discloses using weight after the packer is downhole to expand the leaves B. Thus, Martin fails to anticipate independent claim 1.

Collins discloses a bulging section 18 that expands radially outwardly in response to the longitudinal compression of a sealing assembly 22. *See, for example*, Collins, 4:7-11. However, there is no teaching or suggestion in Collins regarding storing potential energy in the bulging section 18 prior to a packer being run to a predetermined position in a well; and likewise, there is no teaching or suggestion in Collins regarding releasing stored energy from the bulging section 18 to cause the bulging section 18 to radially expand. Thus, Collins fails to anticipate independent claim 1.

Fritsche discloses expanding leaf springs 13. However, Fritsche fails to teach or suggest that the leaf springs 13 store potential energy prior to a packer being run into a well and release the potential energy once the packer is at a predetermined position. To the contrary, Fritsche discloses in lines 2-17 in column 3 that fluid pressure against a piston 17 moves a plunger 16 downwardly, and as can be seen from Fig. 2, this action expands the leaf spring 13. However, there is no teaching or suggestion in Fritsche regarding an energizing element that is adapted to store potential energy prior to a packer being run to a predetermined position in a well; and likewise, there is no teaching or suggestion in Fritsche of an energizing element that is adapted to release at least some of this potential energy at the predetermined position to radially expand the element. Therefore, Fritsche fails to anticipate independent claim 1.

Claims 2, 3, 6 and 9-13 are patentable for at least the reason that these claims depend from an allowable claim. Thus, for at least the reasons that are set forth above, withdrawal of the §§ 102 and 103 rejections of claims 1-3, 6 and 9-13 is requested.

§§ 102 and 103 Rejections of Claims 18 and 19:

The method of independent claim 18 includes storing potential energy in a seal element of a packer before deploying the packer downhole in a well and setting the packer by releasing at least some of the potential energy.

Contrary to the limitations of independent claim 18, Martin fails to teach or suggest storing potential energy in a seal element of a packer before deploying the packer downhole in a well. In this regard, the leaves 18 of Martin do not store potential energy nor do the leaves 18 release potential energy to form a seal in a well. See discussion of independent claim 1 above. Thus, Martin fails to anticipate independent claim 18.

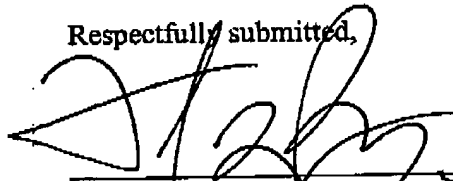
Collins likewise fails to teach or suggest the acts of storing and setting of claim 18. In this regard, Collins is specific that the disclosed bulging section 18 expands radially in response to longitudinal compression. See discussion of independent claim 1 above. Therefore, Collins also fails to anticipate independent claim 18.

Claim 19 is patentable for at least the reason that this claim depends from an allowable claim. Therefore, for at least the reasons that are set forth above, withdrawal of the §§ 102 and 103 rejections of claims 18 and 19 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102, 103 and 112 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0268US).

Respectfully submitted,



Date: November 22, 2005

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